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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/559,772

12/07/2005

Sergio Santini

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5939

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EXAMINER

CHIANG, JENNIFER C

ART UNIT

PAPER NUMBER

3751

NOTIFICATION DATE

DELIVERY MODE

04/04/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketingDept@young-thompson.com

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/559,772	Applicant(s) SANTINI ET AL.	
	Examiner KEEGAN GUMBS	Art Unit 3751	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 January 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1, 4 and 8.
 Claim(s) withdrawn from consideration: 5.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
 13. ☒ Other: See Continuation Sheet.

/Gregory L. Huson/
 Supervisory Patent Examiner, Art Unit 3751

/K. G./
 Examiner, Art Unit 3751

Continuation of 5. Applicant's reply has overcome the following rejection(s): Claim 6 was rejected under 112 2nd paragraph for depending from canceled claim 3 (claim 7, which was withdrawn, also depended from canceled claim 3). The Applicant's reply has overcome the rejection by canceling claim 6 and also canceling withdrawn claim 7 .

Continuation of 13. The arguments presented by the Applicant, even in view of the cancellation of claims 6 and 7, fail to define the Applicant's invention over the prior art of record, namely Okamoto and Fukushima. The Applicant has argued that neither element 21 of Okamoto or the portion designated as the capillary channel of Fukushima (pointed out in the annotated Fig. 3 of Fukushima) constitute capillary channels since both elements are too big to provided a capillary effect. Initially, the examiner would like to point out that the Applicant is giving too narrow of a limitation to the term "capillary". The Applicant is arguing that the "capillary channel" must carry out a capillary effect, i.e. where the ink of the pen moves as a result of the forces of the surface tension of the ink and adhesion forces between the capillary channel and the ink. However, limitations in the claim are given their broadest reasonable interpretation. The term "capillary" can be defined as "having a very small bore" (Merriam-webster online dictionary) or "pertaining to or occurring in or as if in a tube or fine bore" (Dictionary.com). In other words, a "capillary channel" could be a channel comprised of a very small or fine bore. Both Okamoto and Fukushima disclose elements that have a very small bore or pertain to fine bore, thus meeting the limitation of a "capillary channel". Regardless, even if the claim recited limitations pointing to the ink moving by capillary action through the capillary channel the examiner believes that neither capillary channels of Okamoto or Fukushima are "too big" to have a capillary action to help move the ink towards the ball of the pen. For example, when observing Fig. 2 of Okamoto, the space between the outer wall of fluid path 21 and stem 5a appears to be the amount of spacing as the space between the outer wall of bore 23 (i.e. the grooves 24) and the slightly thinner portion of the stem 5a. It is the examiner's position that both Okamoto and Fukushima would use at least some sort of capillary effect to help the ink move through the capillary channels. The Applicant hasn't provided any evidence that either capillary channel is too big besides simpling saying so. Furthermore, that Applicant has argued, with regards to Fukushima, that the capillary hole diameter of 2g is clearly much bigger than the straight portion 4a, and thus the spring can radially move inside the capillary hole 2g (pointing to Fig. 2 and 3). The examiner believes the Applicant is referring to the less detailed Fig. 2 as support for this argument, but when observing Fig. 2, 3 and additionally Fig. 4, it is clear that the the narrow portion (2g) of Fukushima would contain the straight portion (of the spring) in an appoximately complementary manner with a minimum amount of play as required by claim 1. Therefore Okamoto and Fukushima discloses every limitation of claim 1.